UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,258	02/25/2002	Kiran Venkatesh Hegde	50023.09USI1	3975

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EXAMINER
STORK, KYLE R

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/084,258	HEGDE ET AL.
	Examiner	**Art Unit**	
	Kyle R. Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 June 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This final office action is in response to the amendment filed 10 June 2005.

2.   Claims 1-22 are pending. Claims 1, 10, 16, and 22 are independent claims. The

rejection of claim 1-9 under 35 U.S.C. 101 has been withdrawn as necessitated by the

amendment. The rejection of claims 1-22 under 35 U.S.C. 103 have been withdrawn as

necessitated by the amendment.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 10-15 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Section 2106 of the MPEP states:

> (a) Functional Descriptive Material: "Data Structures" Representing Descriptive Material
> Per Se or Computer Programs Representing Computer Listings Per Se
> **Data structures not claimed as embodied in computer-readable media are descriptive**
> **material per se and are not statutory** because they are not capable of causing functional
> change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760
> (claim to a data structure per se held nonstatutory). Such claimed data structures do not
> define any structural and functional interrelationships between the data structure and other
> claimed aspects of the invention which permit the data structure's functionality to be
> realized. In contrast, a claimed computer-readable medium encoded with a data
> structure defines structural and functional interrelationships between the data structure
> and the computer software and hardware components which permit the data structure's
> functionality to be realized, and is thus statutory.
> Similarly, computer programs claimed as computer listings per se, i.e., the descriptions or
> expressions of the programs, are not physical "things." They are neither computer
> components nor statutory processes, as they are not "acts" being performed. Such
> claimed computer programs do not define any structural and functional interrelationships
> between the computer program and other claimed elements of a computer which permit
> the computer program's functionality to be realized. In contrast, a claimed computer-
> readable medium encoded with a computer program is a computer element which defines
> structural and functional interrelationships between the computer program and the rest of
> the computer which permit the computer program's functionality to be realized, and is

thus statutory. Accordingly, it is important to distinguish claims that define descriptive
material per se from claims that define statutory inventions.
Computer programs are often recited as part of a claim. Office personnel should
determine whether the computer program is being claimed as part of an otherwise
statutory manufacture or machine. In such a case, the claim remains statutory irrespective
of the fact that a computer program is included in the claim. The same result occurs when
a computer program is used in a computerized process where the computer executes the
instructions set forth in the computer program. Only when the claimed invention taken as
a whole is directed to a mere program listing, i.e., to only its description or expression, is it
descriptive material per se and hence nonstatutory.

As per independent claim 10, the applicant discloses, "A modulated data signal."

This is non-statutory as a "modulate data signal" is descriptive material per se because

it is not tangibly embodied.

Claims 11-15 are rejected for their dependence upon rejected base claim 10.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 1-3, 5, 8-11, 16-17, and 21-22 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Crow et al. (US 6262724, application 1999, hereafter Crow) in

further in view of Modeste et al. (US 5852800, filed 20 October 1995, hereafter

Modeste)

As per independent claim 1, Crow discloses the method for automatically playing

rich media presentations within an email, a banner ad, and a page, comprising:

- A device coupled to a network (column 8, lines 1-20: Here, the digital processing system is a device coupled to the network)

- Generating the rich media presentation (column 3, lines 14- 19; column 18, lines 30-38: Here, the creation of media files is the generation of the presentation)

- Providing the rich media presentation to the device (column 27, lines 5-8 and column 8, lines 1-20: Here, the media file is transferred over a network to be presented via the display)

- Automatically playing the rich media presentation (column 3, lines 14- 19; column 8, lines 1-20: Here, the presentation can be displayed or saved. The display of the presentation without saving the data is the same as automatically playing the presentation)

Crow fails to specifically disclose the method wherein playback attributes relating to a device are detected. However, Modeste discloses wherein playback attributes relating to a device are detected (column 2, lines 50-65: Here, the device speed and processor speed are detected and the playback is modified based upon the speed).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow's method with Modeste's method, since it would have allowed a user to receive presentations tailored to his/her display device.

As per dependent claim 2, Crow and Modeste disclose the limitations similar to those in claim 1, and the same rejection is incorporated herein. Crow further discloses determining when a rich media presentation is contained within the email, the banner ad, and the page (column 5, lines 54-58; column 6, lines 16-20).

As per dependent claim 3, Crow and Modeste disclose the limitations similar to those in claim 2, and the same rejection is incorporated herein. Crow further discloses when the device supports playing the rich media presentation, optimizing the rich media presentation for the device based on the detected attributes (column 26, line 20- column 27, line 3: Here, the execution code of the software package interacts with the device to provide functionality). Crow fails to specifically disclose when the device does not support playing the presentation, providing the device with a link to the presentation. However, Modeste discloses providing a link to external data (column 5, lines 45-63).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow's method with Modeste's method, since it would have allowed a user whose device does not support the presentation to access the presentation in another manner.

As per dependent claim 5, Crow and Modeste disclose the limitations similar to those in claim 3, and the same rejection is incorporated herein. Crow further discloses the method further comprising providing a client the ability to modify characteristics associated with the rich media presentation (column 18, lines 30-38: Here, editing a presentation is modifying the characteristics).

As per dependent claim 8, Crow and Modeste disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Crow further discloses the method comprising delivering an image to the device that is displayed on the device at a location relating to the rich media presentation (Figure 4, items 248 and 250: Here,

the media source icons are images displayed on the device and the location is related to the corresponding presentation).

As per dependent claim 9, Crow and Modeste disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Crow further discloses the method wherein generating the presentation for the device further comprises:

- Generating a virtual player optimized for the device (column 26, line 20- column 27, line 3)

- Generating a presentation package optimized for the device (column 26, line 20- column 27, line 3: Here, the presentation package includes the functions that are executable on the device)

- Generating the media package for the device (column 2, lines 14-19: Here, the media package is generated and displayed in a primary window)

As per independent claim 10, the applicant discloses the modulate data signal embodied in a carrier wave and representing computer executable instructions for the execution of the method of claims 1 and 2. Claim 10 is similarly rejected under Crow and Modeste.

As per dependent claim 11, the applicant discloses the modulate data signal embodied in a carrier wave and representing computer executable instructions for the execution of the method of claim 3. Claim 11 is similarly rejected under Crow and Modeste.

As per independent claim 16, Crow and Modeste disclose the system for providing rich media presentation within an email, a banner ad, and a page to a device over a network comprising:

- A processor and a computer readable medium (Figure 2, items 152 and 154)

- An operating environment stored on the computer readable medium and execution on the processor (Figure 150, item 150: Here the digital processing system is the operating environment)

- A communication connection device operating under the control of the operating environment (Clark: column 5, lines 38-48: Here, a network is the communication connection)

- A rich media presentation application operating under the control of the operating environment and operative to perform the method of claims 1 and 2 (similarly rejected under Clark and Adams)

- Media playback capabilities relating to a device (Modeste: column 2, lines 50-65)

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow's method with Modeste's method, since it would have allowed a user to receive presentations tailored to his/her display device.

As per dependent claim 17, the applicant discloses the system for the execution of the method of claim 3. Claim 17 is similarly rejected under Crow and Modeste.

As per dependent claim 21, the applicant discloses the system for the execution of the method of claim 8. Claim 21 is similarly rejected under Crow and Modeste.

As per independent claim 22, the applicant discloses a method similar to the method of claims 1 and 2. Claim 22 is similarly rejected under Crow and Modeste.

6.   Claim 7and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crow and Modeste in further in view of Adams (US 2002/0124100, application 2000).

As per dependent claim 7, Crow and Modeste disclose the limitations similar to those in claim 5, and the same rejection is incorporated herein. Crow and Modeste fail to specifically disclose the method wherein providing the rich media presentation to the device, further comprises using an email serving engine. Adams further discloses the method wherein providing the rich media presentation to the device, further comprises using an email serving engine (paragraph 0032: Here, the presentation is emailed to a user).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow and Modeste's method with Adam's method of distributing a presentation through an email serving engine, since it would have allowed a user to view the presentation without specifically visiting the network location containing the presentation.

As per dependent claim 20, the applicant discloses the system for the execution of the method of claim 7. Claim 20 is similarly rejected under Crow, Modeste, and Adams.

7.   Claims 4, 6, 12-15, and 18-19 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Crow and Modeste in further in view of Wade (US 2002/0019831,

application 2001).

As per dependent claim 4, Crow and Modeste disclose the limitations similar to

those in claim 3, and the same rejection is incorporated herein. Crow and Modeste fail

to specifically disclose the method wherein the rich presentation is within the banner ad,

further comprising making the banner ad selectable by the device; and performing an

action when the banner ad is selected. Wade discloses the method wherein the rich

presentation is within the banner ad, further comprising making the banner ad

selectable by the device; and performing an action when the banner ad is selected

(paragraph 0054 and paragraph 0057: Here, an advertisement is presented through a

banner ad. When an action is taken on the ad, the ad server traces the efficiency of the

ad based upon several factors, one being the extent to which the ad was played and the

user interaction with the ad).

It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to have combined Crow and Modeste's method for displaying

presentations with Wade's method of presenting a banner ad and performing actions

when selected, since it would have allowed for a user's preferences to be tracked

through interaction with the ad (Wade: paragraph 0057).

As per dependent claim 6, Crow and Modeste disclose the limitations similar to

those in claim 5, and the same rejection is incorporated herein. Crow and Modeste fail

to specifically disclose utilizing an ad serving engine. Wade discloses utilizing an ad serving engine (paragraph 0052).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow and Modeste's method for displaying presentations with Wade's method of utilizing an ad server, since it would have allowed for ads to be incorporated into web pages viewed by a user.

As per dependent claim 12, the applicant discloses the modulate data signal embodied in a carrier wave and representing computer executable instructions for the execution of the method of claim 4. Claim 12 is similarly rejected under Crow, Modeste, and Wade.

As per dependent claim 13, the applicant discloses the modulate data signal embodied in a carrier wave and representing computer executable instructions for the execution of the method of claim 6. Claim 13 is similarly rejected under Crow, Modeste, and Wade.

As per dependent claim 14, Crow, Modeste, and Wade disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Adams further discloses the data signal wherein providing the rich media presentation to the device, further comprises using an email serving engine (paragraph 0032: Here, the presentation is emailed to a user).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Crow, Modeste, and Wade's data signal for playing presentations with Adam's method of distributing a presentation through an

email serving engine, since it would have allowed a user to view the presentation without specifically visiting the network location containing the presentation.

As per dependent claim 15, Crow, Modeste, and Wade disclose the limitations similar to those in claim 12, and the same rejection is incorporated herein. Crow further discloses the method comprising delivering an image to the device that is displayed on the device at a location relating to the rich media presentation (Figure 4, items 248 and 250: Here, the media source icons are images displayed on the device and the location is related to the corresponding presentation).

As per dependent claim 18, the applicant discloses the system for the execution of the method of claim 4. Claim 18 is similarly rejected under Crow, Modeste, and Wade.

As per dependent claim 19, the applicant discloses the system for the execution of the method of claim 6. Claim 19 is similarly rejected under Crow, Modeste, Wade.

Response to Arguments

8.   Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

As discloses above, the Modeste reference has been added to address the applicant's concerns.

9.   Applicant's arguments with respect to the Crow reference in respect to claims 1, 2, and corresponding claims, have been fully considered but they are not persuasive.

As per independent claim 1, and its corresponding claims, the applicant argues that Crow fails to teach automatically playing back a media presentation (pages 8-9). However, the Examiner respectfully disagrees. Crow discloses that a presentation can be displayed or saved (column 3, lines 14- 19; column 8, lines 1-20). The display of the presentation without saving the data is the same as automatically playing the presentation, similar to real-time media players. When the data is downloaded, it is immediately presented to the user.

As per dependent claim 2, and its corresponding claims, the applicant argues that crow fails to disclose determining media contained within an email, a banner ad, and a page (page 9). However, the Examiner respectfully disagrees. Crow discloses obtaining transferred information from email, text files, and media files (column 5, lines 54-58). Crow further discloses accessing media data from an HTML page (column 6, lines 16-22).

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-

4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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